

REMARKS

This amendment is in response to the Office Action mailed on June 20, 2005 in which Claims 1-38 were rejected. With this amendment, claims 1, 11-15, 19, and 25 are amended. Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

1. Objection to the Drawings

In Section 1 of the Office Action, the Examiner objected to the drawings due to reference character 22 being used to designate both an insert and a central canal in paragraph [0031] of the specification. In response, Applicant has amended paragraph [0031] to recite “central canal 20” in place of “central canal 22.” The central canal 20 is correctly designated in the drawings and therefore Applicant has not amended the drawings. In view of the amendment to the specification, Applicant respectfully requests that the Examiner withdraw the objection to the drawings.

2. Rejection of Claims 1-3, 5-13, 15-18, 25-27, 30-33, and 35 Under 35 U.S.C. § 102(e) as Anticipated by Ganjianpour

In Section 3 of the Office Action, the Examiner rejected claims 1-3, 5-13, 15-18, 25-27, 30-33, and 35 as anticipated by Ganjianpour, U.S. Patent No. 6,716,250. Applicant respectfully requests reconsideration of claims 1-3, 5-13, 15-18, 25-27, 30-33, and 35 in view of the above amendments and the following reasons.

In Section 3 of the Office Action, the Examiner states that the “replacement shaft” limitation in original claim 1 was part of a functional recitation that is “capable of being performed by Ganjianpour.” Applicant has amended claim 1 to positively recite “a replacement shaft” that is a separate member from and in addition to the “shaft” recited earlier in the claim. Ganjianpour does not identically disclose such a replacement shaft separate from the original shaft. In contrast, Ganjianpour discloses a “locking screw 30,” as shown in Figs. 4, 6, and 7. Even if the locking screw 30 of Ganjianpour is construed as a “shaft” as recited in claim 1, the Ganjianpour reference does not disclose any “replacement shaft,” as positively recited in claim 1, as amended. Accordingly, independent claim 1 and

corresponding dependent claims 2-3 and 5-10 are not anticipated by Ganjianpour under 35 U.S.C. § 102(e).

Similar to claim 1, as amended, claim 25 positively recites “a first shaft” and “a second shaft” configured to be coupled to the body. Accordingly, claim 25 and corresponding dependent claims 26-27, 30-33, and 35 are also not anticipated by Ganjianpour.

Independent claim 11, as amended, recites “a shaft . . . configured to extend into a long bone of the patient.” Applicant respectfully asserts that the “locking screw 30” of Ganjianpour is not configured to extend into a long bone of a patient and is instead shown as extending within the “stem 13 inserted into the femur 16 of the patient.” See col. 7, lines 60-61 and Figs. 4 and 7. While Ganjianpour discloses a stem (element 13) that is inserted into a long bone of a patient, the stem 13 of Ganjianpour does not appear to be removable after implantation without also removing the rest of the device, in contrast to the invention of claim 11. Accordingly, independent claim 11 and corresponding dependent claims 12-13 and 15-18 are not anticipated by Ganjianpour and are presented for reconsideration and allowance.

3. Rejection of Claims 3-4, 14, 28-29, and 36-38 Under 35 U.S.C. § 103(a) Based Upon Ganjianpour in View of Pennig

In Section 4 of the Office Action, the Examiner rejected Claims 3-4, 14, 28-29, and 36-38 under 35 U.S.C. § 103(a) as unpatentable over Ganjianpour in view of Pennig, U.S. Patent No. 5,375,956. As discussed above, independent claim 1 has been amended to overcome the rejection based upon Ganjianpour and claim 25 contains a similarly patentable limitation. Pennig does not overcome the deficiencies of Ganjianpour because it does not disclose such a shaft and a separate replacement shaft. Accordingly, dependent claims 3-4, 28-29, and 36-38, which depend from one of claims 1 or 25 are also patentable and are presented for reconsideration and allowance.

With respect to independent claim 11, Pennig discloses a screw that is configured to be threaded into a bone. However, Pennig does not disclose a shaft that may be removed from the patient after implantation of the prosthesis without also removing the body as recited

in claim 11, as amended. Accordingly, Pennig does not overcome the deficiencies of Ganjianpour, and claim 14, which depends from claim 11, is patentable over the combination of Ganjianpour and Pennig and is presented for reconsideration and allowance.

4. Claims 19-24

Independent claim 19 is directed to a method of replacing a shaft of a joint prosthesis and includes the steps of removing a shaft from the patient and replacing the shaft by inserting a replacement shaft into the patient. Accordingly, similar to the reasoning with respect to independent claims 1 and 25, Applicant respectfully asserts that claim 19 and corresponding dependent claims 20-24 are patentable over either Ganjianpour alone or the combination of Ganjianpour and Pennig. In the Office Action, the Examiner did not reject any of claims 19-24 and Applicant respectfully requests an indication of allowance of these claims.

5. Amendments to Claims 1, 11-15, 19, and 25 and New Claims 39-40

Independent claim 1 has been amended to positively recite “a head coupled to the body.” Independent claim 11 has been amended to positively recite “a body coupled to the articular surface” and “a shaft coupled to the body.” Dependent claims 12-15 have been amended accordingly. Independent claim 19 has been amended to positively recite “removing the shaft from the patient without removing the body or the head.” Claim 25 has been amended to positively recite “an articular surface coupled to the body.” New claims 39-40 recite the element of a “neck” that couples the head to the body. The amended claims are supported by the specification, e.g. the exemplary embodiment of FIG. 3 showing the head 14 and articular surface 24 coupled to the body 16 as opposed to the shaft 18. The new claims are supported by the filed specification, e.g. the exemplary embodiment of FIG. 9 showing the head 114 coupled to the body 116 via a neck 113.

CONCLUSION

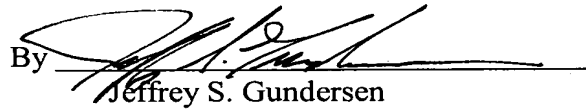
Claims 1-40 are now pending in the present application. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application, as amended, is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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